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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,299	08/31/2006	Susumu Noda	128699	9203
25944 7590 11/17/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
KIANNI, KAVEH C				
ART UNIT		PAPER NUMBER		
2883				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/591,299

**Applicant(s)**

NODA ET AL.

**Examiner**

K. Cyrus Kianni

**Art Unit**

2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuya (JPP 2002-084037, cited/provided by the applicant as prior art 1449).

Tatsuya teaches a two-dimensional photonic crystal ,(see at least figures 1-9) having a slab-shaped body in which modified refractive index areas (see at least page 3-4 transl. ) are cyclically arranged (see at least fig. 1-3 and 6-9), the modified refractive index areas having the same shape and having a refractive index that differs from that of the body ,(see at least fig. 1-3, also at least parag. 0018, 0031), wherein a plane shape of each modified refractive index area is a polygon (see at least fig. 1-3 and 6-9, also at least parag. 0018, 0031); the corners are removed along an arc ,(see at least

fig. 1-3 and 6-9); the modified refractive index areas are arranged in a triangular lattice pattern; the polygon is an equilateral triangle (see at least fig. 1-3 and 6-9).

However, Tatsuya does not specifically state that the above modified refractive index areas having corners that are removed, and refractive index of the body is within a range from 3.15 to 3.55; and a radius  $r_a$  of the arc satisfies the equation stated in claim 1. Although the limitation 'corners are removed' is a process/method language and no patentable weight is given, nevertheless, Tatsuya states that etching process is carried out for forming the photonic crystal (see 0045), and that different refractive indices were used in the process (at least 0018), and that the diameter of the hole/arc is controllable by extending etching (see 0040). Thus, it would have been obvious to a person of ordinary skill in the art when the invention was made to mere as a matter of design configuration to use different parameters for making the suggested photonic crystal since such modifications would provide comparatively simple, and controllability or repeatability process of making the photonic crystal (see 0005), and since it is been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)

### ***Response to Arguments and Amendment***

Applicant's argument filed on 8/21/08 have been fully considered but except for the reference Scherer US 6711200 they are not persuasive.

Applicant asserts and argues that Tatsuya does not teach a plane shape of each modified refractive index area is a polygon whose corners are removed. The examiner responds that this limitation in an structural/product term implies that a plane shape of each modified refractive index area is a polygon (limitation which is obviously given patentable weight). But such shape is obtained by removing corners of the refractive index area (which is process/method of making limitation which is not given weight by the examiner). The applicant though agrees that Scherer teaches such polygonal structures having modifying refractive index but argues that the final product of the claimed invention has different characteristic than that of Tatsuya. Applicant further states that "As discussed below, the structural limitation of removing the corners of the polygon-shaped modified refractive index area has some functional benefits, however, these benefits are not recited in the claims". The examiner responds that unless the applicant narrows the scope of the invention either through physical/structural limitation or novel characteristics of the invention that would distinguish with that of the prior art the presently claimed limitations in the claims will not be patentable over at least Tatsuya's teachings.

- **Applicant is kindly advised to appropriately narrow the scope of the invention in order to allow the case.**

***THIS ACTION IS MADE FINAL***

This action in response to applicant's amendment made FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory

period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Cyrus Kianni whose telephone number is 571-272-2417. The examiner can normally be reached on 9:30-19:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2883

K. Cyrus Kianni

/Kianni C Kaveh/

Primary Examiner, Art Unit 2883

November 12, 2008

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